

Remarks

Amendments to claims

Claim 22 is amended to recite that the isolated nucleic acid molecule comprises a nucleic acid sequence that encodes an SREBP polypeptide comprising the amino acid sequence of SEQ ID NO:2. No new matter is added.

Status of claims

Claims 1, 2, 13, 14, 16-18, 22, 23, and 25-28, and 34-36 are pending. The office action indicated that claim 24 was pending. However, this claim was canceled in the amendment mailed April 6, 2001.

New matter rejection

In part 5 of the office action the examiner objected to the specification as having been amended to contain new matter in view of the addition of SEQ ID NOs 94 and 95; and the claims reciting these sequences were rejected under 35 U.S.C. § 112, 1st paragraph for lack of written description. Genbank entry no. GI3875380 was incorporated by reference in the originally filed specification, and was subsequently incorporated into the specification as SEQ ID NO:94. The examiner asserted that the “sequence revision history of GI3875380 indicates that it was revised 24 times since it was first deposited” and that “Applicants have not provided any evidence as to which of these 24 sequences the sequence submitted in SEQ ID NO:94 corresponds to.” The examiner made reference to an “attached printout of the locus CAA87777”, but no such printout was attached to the office action. In any event, a quick review of the revision history for Genbank entry GI3875380 shows that the sequence that was in the entry as of the filing date of June 14, 1999 (i.e. the entry dated March 7, 1999), is identical to the sequence that was in the entry as of January 3, 2002 (i.e. the entry dated September 20, 2001). A sequence alignment of these two entries is attached as Exhibit A.

Regarding the incorporation of SEQ ID NO:95, the Examiner noted that “GI1559384 is not a protein sequence, rather a nucleotide sequence.” The protein sequence set forth in SEQ ID NO:95 was incorporated in the original specification by reference to Rawson *et al.* on page 44, line 33. Rawson *et al.* was provided as reference BU in the Information Disclosure Statement filed February 22, 2000. Figure 1, on p. 49 of that reference, provides the amino acid sequence of *C. elegans* S2P, which was incorporated as SEQ ID NO:95.

The undersigned declared in the “Transmittal of Replacement Sequence Listing” filed January 3, 2002, that the “amendatory material consists of the same material incorporated by reference in the captioned application”. Accordingly, it is believed that the requirements for amending a specification to include material that was originally incorporated by reference have been satisfied, and that the rejections raised by the examiner should be withdrawn.

Enablement rejection

In part 8 of the office action, claims 22, 23 and 25-28 were rejected under 35 U.S.C. §112, 1st paragraph, for lack of enablement. Claim 22 is amended to recite that the isolated nucleic acid molecule comprises a nucleic acid sequence that encodes an SREBP polypeptide comprising the amino acid sequence of SEQ ID NO:2. Due to the degenerate nature of the genetic code, one skilled in the art can predict with certainty nucleotide sequences, in addition to the exemplified SEQ ID NO:1, that encode the amino acid sequence of SEQ ID NO:2. Thus, the full scope of claim 22 is enabled, and the rejection should be withdrawn.

Rejections under 35 U.S.C. §112, 2nd paragraph

In paragraph 10 of the office action, Claims 1-4, 6, 8-11, 13-18, and 34-36 were rejected as indefinite. While rationale was provided for the rejection of claims 2 and 22, there is no indication as to how this rejection is being applied to claims 1, 13, 14, 16, 17, 18, and 34-36. Clarification is requested.

The Examiner stated that “Claim 2 is indefinite because it is whether [sic] ‘that has been’ refers to ‘C.elegans’ or ‘claim 1’”. Applicants respectfully disagree. Claim 2 as written is grammatically correct, clear and concise. Nobody proficient in the English language would interpret claim 2 as referring to a “genetically modified claim 1”, as such interpretation would be nonsensical. The Examiner’s suggested remedial language adds unnecessary verbiage, and thus is contrary to the “distinctly claim” provision of 35 U.S.C. §112.

Claim 22 was rejected because of the “(ab)” designation in line 2. This was a typographical error that was introduced into Claim 22 as reproduced in Appendices A and B filed with the Amendment dated January 3, 2002. However, the claim as originally filed refers to “(a)”, and no subsequent amendments were made to replace this with “(ab)”. In any event, it is believed that the rejection is moot in light of the current amendment to claim 22. Further, the Examiner’s rejection based on the term “functionally active” is also overcome by the current amendment.

For the above reasons, it is believed that the rejections raised under 35 U.S.C. §112, 2nd paragraph, should be withdrawn.

Closing remarks

It is believed that all of the rejections are overcome, and that the claims are in condition for allowance. The examiner is encouraged to telephone the undersigned to discuss any further issues that may need resolution prior to allowance.

Respectfully submitted,

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Jan P. Brunelle

Reg. No. 35,081

EXELIXIS, INC.

170 Harbor Way

P.O. Box 511

South San Francisco, California 94083-0511

Telephone: (650) 837-8180

Facsimile: (650) 837-8234